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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,805	02/04/2004	Clay Fisher	Sony-05900	3337
36813	7590	09/12/2007		
O'BANION & RITCHIE LLP/ SONY ELECTRONICS, INC. 400 CAPITOL MALL SUITE 1550 SACRAMENTO, CA 95814			EXAMINER DAYE, CHELCIE L	
			ART UNIT 2161	PAPER NUMBER
			MAIL DATE 09/12/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/771,805	FISHER ET AL.
	Examiner Chelcie Daye	Art Unit 2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 26 July 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 1-10 and 17-28 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-10 and 17-28 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 2161

### **DETAILED ACTION**

1. This action is issued in response to applicant's amendment filed July 26, 2007.
2. Claims 1-10 and 17-28 are presented. No claims added and claims 11-16 remain cancelled.
3. Claims 1-10 and 17-28 are pending.
4. Applicant's arguments filed July 26, 2007, have been fully considered but they are not persuasive.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-10 and 17-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Satomi (US Patent Application No. 20030063304) filed September 26, 2002, in view of Ohta (US Patent No. 7,188,224) filed August 28, 2003.**

Regarding Claims 1,10,17,18, and 24-28, Satomi discloses a method comprising: receiving a request corresponding to a specific content (i.e., "a button 2907 is a button for deleting an album. A button 2908 is a button for uploading image data. A button 2909 is a print order button. ([0203]) ...If it is

determined in step S3105 that creation of a new album is not selected, it is checked in step S3107 whether deletion of an album is selected. If the button 2907 is pressed, it is determined that deletion of an album is selected, and the flow advances to step S3108. If the button 2907 is pressed, a window 3400 shown in FIG. 33 is displayed to allow the user to delete the selected album. (FIG. 33; [0219]) ... When the print order button 2909 on the window 2900 is pressed, the photosite 105 searches the album image data table 800 to acquire and image count N of the currently selected album in step S4801. ([0274]) ... In step S4805, the photosite 105 searches the album image data table 800 in the database 118 for a record whose image display number is I, and acquires the image ID 802 of the image. The photosite 105 also searches the image information data table 900 for a record with image information having the image ID 901. From the searched information data table 900, the photosite 105 acquires the file path 904 to the original image, ([0278])..." The preceding text excerpts clearly indicate that a user can request over the network (i.e., interact) to print, delete, upload etc. a specific image album or image in the photosite system (server). The photosite system based on the type of the request (e.g., delete, print etc.) searches/reviews/analyzes information in a database (e.g., album image data table i.e., information related to the specified image, album etc.) and selectively asks the user to confirm the request (e.g., a delete request to delete a specific album) and based on the users confirmation response, processes/performs the requested job (i.e., delete the image or image album

etc.); reviewing a record associated with the specific content in response to the request (please see explanation above; [0116];[0274];[0278]); selectively transmitting a confirmation for the request based on the reviewing (please see explanation above; [0219]; Fig. 33); and performing the request in response to receiving the request and instruction from the user in responding to said confirmation (please see explanation above; [0203];[0219]). However, Satomi is silent with respect to duplicates of said specific content are retained across multiple devices configured for communicating with one another over a network and response to the request based on the presence of any duplicate or related content.

On the other hand, Ohta discloses duplicates of said specific content are retained across multiple devices configured for communicating with one another over a network (column 34, lines 58-64, Ohta) and response to the request based on the presence of any duplicate or related content (column 36, lines 7-29, Ohta). Satomi and Ohta are analogous art because they are from the same field of endeavor of data processing. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Ohta's teachings into the Satomi system. A skilled artisan would have been motivated to combine as suggested by Ohta at column 1, lines 33-47, in order to present an invention, which provides a networked apparatus that facilitates highly convenient, content duplication management. Thus, alleviating the prior problems of meeting the users need for high usability within a network environment.

Regarding Claim 2, the combination of Satomi in view of Ohta, disclose the method wherein the reviewing further comprises using a preference corresponding with the request to determine whether the confirmation is transmitted ([0265], Satomi).

Regarding Claims 3,4, and 20, the combination of Satomi in view of Ohta, disclose the method wherein said preference is based on the type of request ([0265], [0271], [0274], Satomi).

Satomi is silent with respect to determining utilization of any duplicate or related content.

Ohta discloses determining utilization of any duplicate or related content (column 34, lines 57-64, Ohta). It would have been obvious to a person of ordinary skill in the art at the time of invention to modify the teachings of Satomi with the teachings of Ohta to include determining utilization of any duplicate or related content with the motivation to provide a networked apparatus that facilitates highly convenient content duplication (column 1, lines 33-47, Ohta).

Regarding Claims 5 and 19, the combination of Satomi in view of Ohta, disclose the method wherein said specific content includes one from the group of content items consisting of a photograph, music, a document, and a video ([0088], Satomi).

Regarding Claims 6 and 23, the combination of Satomi in view of Ohta, disclose the method wherein the request includes one from the group of request types consisting of saving, deleting, modifying, and printing the specific content ([0091], Satomi).

Regarding Claims 7 and 21, the combination of Satomi in view of Ohta, disclose the method further comprising storing the preference in a storage device (Figs.1&2, Satomi).

Regarding Claims 8 and 22, the combination of Satomi in view of Ohta, disclose the method further comprising storing the record in a storage device (Figs.1&2, Satomi).

Regarding Claim 9, the combination of Satomi in view of Ohta, disclose the method wherein the confirmation asks the user for authorization for executing the request (column 38, lines 4-27, Ohta).

### ***Response to Arguments***

*Applicant argues, Ohta does not teach responding to a request based on the presence of any duplicate or related content.*

Examiner respectfully disagrees. Ohta states, "*The permitted number of duplications represents the right to duplicate the content to another device up to that number of times. Note that the permitted number of duplications is a sum of two numbers that are permitted separately for duplications to a first type device and to a second type device. The first type device refers to a device that duplicates a content to a non-portable recording medium, and the second type device refers to a device that duplicates a content to a portable recording medium.* As shown in FIG. 21, the permitted number of duplications in content information 1121 is "10 (first type: 5, and second type: 5)", which means that it is permitted to duplicate the content to a first type device up to five times, and to a second type device up to another five times...*The flag indicating whether or not content duplication to an out-group device is permitted is set to either "OK" or "NG". When set to "OK", the flag indicates that duplication of the content to an out-group device is permitted. When set to "NG", on the other hand, the flag indicates that duplication of the content to an out-group device is prohibited.* As shown in FIG. 21, the flag in this embodiment is set to "NG", which means that duplication of content 1122 to an out-group device is prohibited" (column 36, lines 7-29). The preceding excerpt discusses the permission to duplicate content from one device to another a certain number of times. Dependent upon the restricted number of times and the already stored number of duplicated content, determines whether more duplicated content can be added. If the restricted number for duplicated content has exceeded its threshold an "NG" flag is set to indicate prohibition of the addition of the content. However, if the restricted number for duplicated content has not exceeded its threshold an "OK" flag is set to indicate permission is granted. Therefore showing that based on presence of the duplicated content a positive or negative response is outputted. Even further, Ohta discloses, "*When judging that the requested number of duplications is within the permitted number, update unit 1312 outputs an instruction to home server 1100 via communication unit 1305. The instruction is to have home server 1100 add the requested number of duplications "2 (first type: 1, and second type: 1)" to the*

*permitted number of duplications stored in home server 1100, correspondingly to the content identifier "A-0001"...In response, home server 1100 updates the stored duplication restricting information 1152 included in content information 1153 (shown in FIG. 24B) by adding the requested number of duplications "2 (first type: 1, and second type: 1)" to the currently held permitted number of duplications. FIG. 30A shows the updated content information 1172 that includes duplication restricting information 1171"* (column 49, lines 8-22). As understood from the citation above, after judging the received request and permission is granted, an update unit adds the requested duplications to the corresponding devices. Then a response is also sent to the stored duplication restricting information to update the content information in order to keep track of the currently held (i.e., available) permitted number of duplications. As a result, a full disclosure of the above-argued limitation has been provided.

*Applicant argues, Ohta does not teach that duplicates of said specific content are retained across multiple devices configured for communicating with one another over a network.*

Examiner respectfully disagrees. Ohta states “one aspect of the present invention provides a networked apparatus that belongs to a group and that is connected via a network to at least one device in the group and to at least one device out of the group. The networked apparatus: stores a content; receives, from a device, a duplication request for the content; judges whether the device is in the group or out of the group; and duplicates the content to the device if the device is judged to be in the group, and imposes restrictions on duplication of the content to the device if the device is judged to be out of the group” (column 1, lines 57-67) and “Content duplication management system 1000 is a system for receiving contents that are broadcast from a broadcast station or transmitted over a network, and for allowing the member devices of a group formed by AD server 100 to use the received contents.”

*Hereinafter, a description is given of an example in which content duplication management system 1000 receives contents from a broadcast station" (column 34, lines 58-64). One of ordinary skill in the art would realize that a network itself is a communication system connecting two or more computers (i.e., devices) so that they can share resources (i.e., content). As understood from the preceding excerpts the present invention is a group of devices connected via a network in order to transmit and store duplication content. As such fully disclosing the above-argued limitation.*

*Applicant argues a skilled artisan would not be motivated to combine the two references of Satomi and Ohta in order to arrive at the present invention.*

Examiner respectfully disagrees. In response to applicant's argument that there is no motivation to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner fully believes that all of the claimed features as recited have been fully taught.

*Applicant argues, in regard to claim 10, that the action fails to address the fact that the claim is written in means plus function form under 35 USC 112, sixth paragraph.*

Examiner respectfully disagrees. Applicant's argument are deemed improper because "If the functionally-defined disclosed means and their equivalents are so broad that they encompass any and every means for performing the recited functions...the burden must be placed on the applicant to demonstrate that the claims are truly drawn to specific apparatus distinct from other apparatus capable of performing the identical functions "); In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 229 (CCPA 1971) (a case in which the court treated as improper a rejection under 35 U.S.C. 112, second paragraph, of functional language, but noted that "where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristics relied on "); and In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980) (a case indicating that the burden of proof can be shifted to the applicant to show that the subject matter of the prior art does not possess the characteristic relied on whether the rejection is based on inherency under 35 U.S.C. 102 or obviousness under 35 U.S.C. 103). Applicant has failed to point out specific examples within their own specification of the exact means for each function discussed within independent claim 10 and even further details of how the prior art used does not provide adequate support for such means. As a result, the examiner believes the limitations for the means plus function language has been met.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

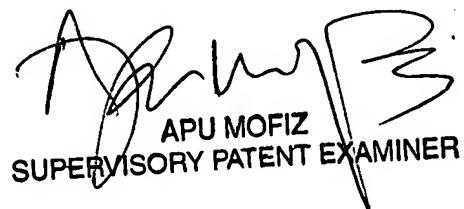
***Points of Contact***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chelcie Daye whose telephone number is 571-272-3891. The examiner can normally be reached on M-F, 7:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chelcie Daye  
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September 6, 2007



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